REMARKS

The Office Action mailed April 7, 2009 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Claim Status

Claims 1 – 14 are pending. By this Amendment, Applicant has amended Claim 5 in order to clarify and to further point out, with particularity the subject matter that Applicant regards as the invention and cancelled Claims 12 – 14. Consequently, the claims under consideration are believed to include Claims 1 – 11.

Claim Provisional Rejections for Nonstatutory Double Patenting

Claims 1 – 14 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 – 25 of U.S. Patent No. 6,911,116 B2. This rejection is respectfully overcome.

The current Application and U.S. Patent No. 6,911,116 B2 are commonly owned. The Applicant has, concomitantly with this Amendment, filed a terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) to overcome the provisional rejection based on a nonstatutory obviousness-type double patenting ground.

Claims 1 – 14 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 – 13 of U.S. Patent No. 7,198,731 B2. This rejection is respectfully overcome.

The current Application and U.S. Patent No. 7,198,731 B2 are commonly owned. The Applicant has, concomitantly with this Amendment, filed a terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) to overcome the provisional rejection based on a nonstatutory obviousness-type double patenting ground.

Claim Rejections under § 112

Claim 5 stands rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully overcomes this rejection.

By this Amendment, Applicant has amended Claim 5, to remove the reference to preservatives or complexing agents as proffered by the Office, as such the Applicant courteously requests reconsideration and withdrawal of the rejection of Claim 5 under 35 USC §112, first paragraph.

Claim Rejections Under 35 USC § 102/103

Claims 1-2, 5-6, 9-10, 11 and 12-14 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohringer et al., (WO 98/42685). The rejection to Claims 1-2, 5-6, 9-10, and 11 is respectfully traversed. Claims 12-14 have been cancelled by this Amendment, the rejection of these claims is moot.

It is well settled that to anticipate a claim, a single source must contain all of the elements of the claim. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

The instant invention claims storage stable aqueous solutions of fluorescent whitening agents with high concentrations of fluorescent whitening agents, which are nevertheless storage stable against precipitation. WO 98/42685 A does not disclose such storage stable aqueous solutions of high concentration which are storage stable against precipitation.

The aqueous solution of example 9 of WO 98/42685 A has a concentration of 17.5% by weight, which is equivalent to 0.114 mol/kg. This is far away from the instantly claimed minimum concentration of 0.214 mol/kg. Therefore, fluorescent whitening agent solutions with an amount of the optical brightener being higher than 0.214 mol/kg are not disclosed in WO 98/42685 A.

In each and every instance WO 98/42685 A disclose a maximum concentration of 17.5% by weight, which is equivalent to 0.114 mol/kg. Therefore, WO 98/42685 A can not anticipate Claim 1 or any claims depending therefrom.

In view of the above, it is believed that the §102 rejection has been overcome. Applicants, therefore, courteously solicit reconsideration and withdrawal of the rejection.

In the alternative Claims 1-2, 5-6, 9-10, 11 and 12-14 stand rejected under 35 U.S.C. 103(a) as obvious over Rohringer et al., (WO 98/42685). As previously stated, the rejection to Claims 1-2, 5-6, 9-10, and 11 is respectfully traversed. Claims 12-14 have been cancelled by this Amendment, the rejection of these claims is moot.

With respect to independent claim 1, the Office is of the position that:

> "Since Rohringer et al. teach the same composition and method as claimed, the aqueous solution composition of Rohringer et al. would inherently be the same as claimed (e.g. amount of 0.214 ml/kg and no solubilzing agent). If there is any difference between the product of Rohringer et al. and the product of the instant claims, the difference would have been minor and obvious. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable."

In order to make a *prima facie* case of obviousness, it is beyond contention that each and every aspect of a claimed invention must be taught by the prior art. Here, the Office fails to establish a *prima facie* case for this exact reason. The prior art does not teach, disclose or suggest a storage stable aqueous solution, comprising at least one optical brightener in a concentration higher than 0.214 mol/kg and no solubilizing agent is contained in the solution as defined by independent claim 1. Given this deficiency, for at least this reason, it is respectfully submitted that the Office has not made a *prima facie* case of obviousness with regard to Claims 1-2, 5-6, 9-10, and 11.

In view of the foregoing, it is respectfully contended that the 35 USC § 103 rejection has been traversed. In consequence, Applicants courteously solicit reconsideration and withdrawal of the rejection.

Claim Rejections Under 35 USC § 103

Claims 3, 4, 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rohringer et al. (WO 98/42685) as applied to claims 1-2, 5-6, 9-10, 11 and 12-14 above, and further in view of Farrar et al. (Pat. No. US 6,911,116 B2). This rejection is respectfully traversed.

With respect to independent claim 1, the Office is of the position that:

> "Since Rohringer et al. teach the same composition and method as claimed, the aqueous solution composition of Rohringer et al. would inherently be the same as claimed (e.g. amount of 0.214 ml/kg and no solubilzing agent). If there is any difference between the product of Rohringer et al. and the product of the instant claims, the difference would have been minor and obvious. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable."

And yet, at the bottom of page 7, the Office admits, "However, Rohringer et al. do not expressly disclose that the method, wherein the removal of the alkali metal of amines salt is done by membrane filteration."

The Office attempts to invoke Farrar, et al., for the teaching of membrane filtration, and/or its combination with any further desired components, e.g. with an additive that stops the growth of disturbing micro-organisms or with a biocide e.g. in a concentration of 0.001 to 0.1% by weight referred to the liquid composition (Col. 11, lines 6367; Col. 12, lines 1-4) corresponding to the instant applicant's limitation claims 7, and 8.

However, the Office, courteously stated, is in error when combining Farrar, et al. with the instant invention. In Farrar, et al., respectfully stated the concern is producing the aqueous solution formed in example 1 of WO 03/044275 A1 which is a mixture of three optical brighteners, the total concentration of them is about 0.125

mol/kg, of which the optical brightener of the instant claim represents only about 0.05 mol/kg, again this is far away from the instantly claimed minimum of 0.214 mol/kg.

Claims 1 to 14 do not overlap with Rohringer et al. (WO 98/42685) and Farrar et al., (Pat. No. US 6,911,116 B2). These are starkly different products. Therefore neither Rohringer et al. (WO 98/42685) nor Farrar et al., (Pat. No. US 6,911,116 B2) gives any hint or motivation to reach the claimed high concentration range. Even if membrane filtration or segregation to remove by-product salt represents conventional technical means, the skilled person would not have considered to increase the concentration and to remove by-product salts to increase solubility,

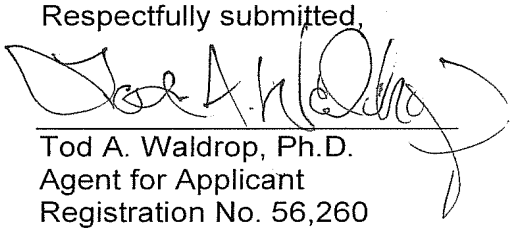
In order to make a *prima facie* case of obviousness, it is beyond contention that each and every aspect of a claimed invention must be taught by the prior art. Here, the Office fails to establish a *prima facie* case for this exact reason. The prior art does not teach, disclose or suggest a storage stable aqueous solution, comprising at least one optical brightener in a concentration higher than 0.214 mol/kg and no solubilizing agent is contained in the solution as defined by independent claim 1. Given this deficiency, for at least this reason, it is respectfully submitted that the Office has not made a *prima facie* case of obviousness with regard to Claims 3, 4, 7 and 8.

In view of the foregoing, it is respectfully contended that the 35 USC § 103 rejection has been traversed. In consequence, Applicants courteously solicit reconsideration and withdrawal of the rejection.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However, if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, please contact the Agent for Applicant at the telephone number provided below.

Respectfully submitted,



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